

Remarks

I. Introduction

This Amendment and Request for Continued Examination (this "Amendment") is submitted in response to the Advisory Action mailed March 8, 2005. A complete listing of all pending claims is submitted herewith. Claims 27-42 are pending in the above-identified application. All the pending claims have been rejected. This Amendment is believed to place the above-identified application in condition for allowance. No new matter has been added to this application by this Amendment.

II. The Rejections Under 35 U.S.C. 103 Should be Withdrawn

Claims 27-29 and 40-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,750,026 to Gadkaree ("Gadkaree") in view of EPO reference number 0,254,551 ("EPO '551"). Applicants acknowledge that the rejections of the claims under 35 U.S.C. § 103(a) have *not* been withdrawn, and such rejections are addressed herein.¹

In addition to the arguments raised in Applicants' Amendment dated December 22, 2004, Applicants respond to the proposed combination of references cited by the Examiner. In the Final Office Action, the Examiner argued that the motivation to combine Gadkaree with EPO '551 was that "the formed porous monolith made by either method has overlapping properties with respect to resistivity, wall thickness and open

¹ The first advisory action, dated January 4, 2005, addressed formal rejections and did not specifically state that the prior art rejections were being maintained. The second advisory action, dated March 8, 2005, clarified that the prior art rejections noted in the final office action were being maintained.

porosity, and thus would be expected to be useable in place of each other.” (Final Office Action, paragraph 3).

Applicants respectfully disagree with this characterization of the prior art references, *i.e.*, the interchangeability of the filter of EPO ‘551 for the filter of Gadkaree. In particular, Applicants are unable to confirm the Examiner’s statement that Gadkaree and EPO ‘551 disclose monoliths having overlapping resistivity properties. As Applicants understand the reference, Gadkaree does not specifically describe the resistivity of the carbon filter itself. Rather, to the extent Gadkaree mentions resistivity, the carbon filter appears to be used with an *additional* element, the “electrically conducting means,” to obtain the quoted resistivity (Gadkaree, column 8, lines 33-58). As described in greater detail in U.S. Patent No. 6,097,011 (the “‘011 Patent”), which was incorporated by reference in Gadkaree, the resistivity was obtained by the use of a “conductive coating” applied over the activated carbon structure and “differentiated from the carbon coating in carbon coated structures” (the ‘011 patent, column 7, lines 6-10). The conductive coating described therein is, for example, a metallic coating such as silver paint, which is used to coat the honeycomb filter (the ‘011 patent, column 9, line 61 - column 10, line 54). Applicants were not able to locate a comparable reference in EPO ‘551 which disclosed the resistivity of the carbon filter described therein. Based on the above, Applicants do not believe that the Examiner is comparing equivalent characteristics of the two references. Accordingly, due to the apparent lack of support for the Examiner’s proposed conclusions, Applicants do not believe that the filter of EPO ‘551 may be substituted for the filter of Gadkaree without hindsight reference to

Applicants' disclosure. Without the proper motivation to combine, claim 27 is believed nonobvious over the combination of references.

Claim 28 depends from claim 27 is thus believed allowable over the combination of references at least for the reasons discussed above. In addition, Claim 28 recites that “the porous carbon *monolith* has a resistivity of between 0.1 and 50 *ohms/m*.” Gadkaree neither discloses nor suggests such a feature. In particular, Gadkaree states that the resistivity of a body, *which includes a conducting means*, is “about 0.10 *ohm.cm* and 25 *ohm.cm*.” (column 8, lines 54-60). Gadkaree appears to refer to different elements (carbon filter *with* conducting means) and different units of measurement (ohms/m *vs.* ohm.cm). Claim 28 is thus not believed obvious in the view of the combination of references, and withdrawal of the rejection is requested.

Claim 29 and 40-42 either depend from claim 27 or incorporate the same terms as claim 27 and are believed to be allowable over the combination of references cited above. Therefore, reconsideration and withdrawal of the rejection of claims 27-29 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Gadkaree in view of EPO ‘551 is respectfully requested.

Claim 30 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gadkaree in view of EPO ‘551 further in view of U.S. Patent No. 5,914,294 to Park et al. (“Park et al.”). Applicant respectfully traverse the rejection. As stated above, Gadkaree et al. combined with EPO ‘551 fails to set forth a *prima facie* case of obviousness with respect to independent claim 27. The addition of Park et al. also does not set forth a *prima facie* case of obviousness with respect to independent claim 27. As claim 30 depends from claim 27, which is believed allowable for at least the reasons

discussed above, dependent claim 30 is also allowable. Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of claim 30 under 35 U.S.C. 103(a) is respectfully requested.

Claims 31-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gadkaree in view of EPO ‘551 further in view of U.S. Patent No. 5,110,328 to Yokota et al. (“Yokota et al.”). Applicant respectfully traverse the rejections. As stated above, Gadkaree combined with EPO ‘551 fails to set forth a *prima facie* case of obviousness with respect to independent claim 27. The addition of Yokota et al. also does not set forth a *prima facie* case of obviousness with respect to independent claim 27. As claims 31-36 depend from claim 27, which is believed allowable for at least the reasons discussed above, these dependent claims are also allowable. Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of claims 31-36 under 35 U.S.C. 103(a) is respectfully requested.

Claims 37-39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gadkaree in view of EPO ‘551 further in view of Yokota et al. and U.S. Patent No. 5,628,819 to Mastemaker et al. (“Mastemaker et al.”). Applicant respectfully traverse the rejections. As stated above, Gadkaree et al. combined with EPO ‘551 fails to set forth a *prima facie* case of obviousness with respect to independent claim 27. The addition of Yokota et al. and Mastemaker et al. also does not set forth a *prima facie* case of obviousness with respect to independent claim 27. As claims 37-39 depend from claim 27, which is believed allowable for at least the reasons discussed above, these dependent claims are also allowable. Therefore, in view of the foregoing, reconsideration

and withdrawal of the rejection of claims 37-39 under 35 U.S.C. 103(a) is respectfully requested.

III. Conclusion

In view of the above remarks, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,



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